

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 28-48 are pending in the application, with claim 28 being the sole independent claim. Claims 1-27 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. New claims 28-48 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested. Support for the new claims can be found at least in the cancelled claims and throughout the specification, especially at pages 12 and 17-26.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Objection to the Specification

In the Office Action at page 2, the Examiner has indicated that Applicants have not complied with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120. The Examiner has requested that Applicants amend the specification to include references to prior applications. Applicants respectfully submit that, in light of the Application Data Sheet filed December 5, 2001, such amendment is not required. *See* 37 C.F.R. § 1.76(b)(5). Reconsideration and withdrawal of this objection are respectfully requested.

Objection to the Drawing

In the Office Action at page 2, the Examiner has objected to the drawings because

the word "oligonucleotide" is misspelled. Submitted herewith is one sheet of a substitute formal drawing of Figure 1, corresponding to the formal drawing of Figure 1 submitted December 5, 2001. It is noted that the substitute formal drawing submitted herewith has the correction to the misspelled word marked in red. Therefore, withdrawal of this objection is respectfully requested.

Claim Objections

In the Office Action at pages 2 and 3, the Examiner has objected to claims 2, 16 and 20 for various informalities. In addition, the Examiner has objected to claim 10 for failing to further limit the subject matter of a previous claim. Applicants traverse these objections. Claims 2, 10, 16, and 20 have been cancelled. By cancellation of these claims, Applicants do not acquiesce with the Examiner's position but only wish to advance the prosecution of the present application. Thus, the basis for these objections are rendered moot. Withdrawal of these objections is respectfully requested.

Rejection under 35 U.S.C. § 112, Second Paragraph

In the Office Action at pages 3-5, the Examiner has rejected claims 1-27 as allegedly indefinite. Applicants traverse this rejection. Claims 1-27 have been cancelled. Thus, the basis for this rejection is rendered moot. By cancellation of these claims, Applicants do not acquiesce with the Examiner's position but only wish to advance the prosecution of the present application. Withdrawal of this rejection is respectfully requested.

Rejection under 35 U.S.C. § 102

In the Office Action at page 6, the Examiner has rejected to claims 1, 5, 7-12, and 25-27 under 35 U.S.C. § 102(b) as allegedly anticipated by Mullis *et al.* (U.S. Patent No. 4,800,159, IDS document AA1). Applicants traverse this rejection.

In the interest of expediting the prosecution of the present application, claims 1, 5, 7-12, and 25-27 have been cancelled. Therefore the basis for this rejection is rendered moot. By cancellation of these claims, Applicants do not acquiesce with the Examiner's position but only wish to advance the prosecution of the present application.

New claim 28 and dependent claims 29-48 are drawn to for recovering a desired target nucleic acid molecule from a sample comprising:

- (A) incubating said sample in the presence of a haptenylated nucleic acid probe molecule under conditions sufficient to permit said probe to hybridize to said desired target molecule thereby forming a hybridized molecule;
- (B) incubating said hybridized molecule in the presence of a binding ligand under conditions sufficient to permit said hybridized molecule to become bound to said binding ligand;
- (C) obtaining said hybridized molecule and treating said molecule under conditions sufficient to make said molecule double stranded; and
- (D) transforming a host cell with said double stranded molecule.

Under 35 U.S.C. § 102, a claim can only be anticipated if every element in the claim is expressly or inherently disclosed in a single prior art reference. *See Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026

(1984); *see also PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996) (“[t]o anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.”). This burden is not met by the disclosure of Mullis *et al.* Mullis discloses a method of PCR amplification and clearly do not disclose all the elements of claims 28-48. Thus, the claims are clearly not anticipated by Mullis *et al.* Reconsideration and withdrawal of this rejection are respectfully requested.

Rejections under 35 U.S.C. § 103

In the Office Action at pages 7-9, the Examiner has rejected claims 1, 2, 5-8, 10-19, 22, 23 and 25-27 under 35 U.S.C. § 103(a) as allegedly unpatentable over Pruitt (*Gene* 66:121-134 (1988), IDS document number AT6) in view of Wieland *et al.* (*Proc. Natl. Acad. Sci. USA* 87:2720-2724 (1990), IDS document number AR11) and Rubenstein *et al.* (*Nucl. Acids Res.* 18:4833-4842 (1990), IDS document number AT7). Applicants respectfully traverse this rejection.

In the interest of expediting the prosecution of the present application, claims 1, 2, 5-8, 10-19, 22, 23 and 25-27 have been cancelled. Therefore the basis for this rejection is rendered moot. By cancellation of these claims, Applicants do not acquiesce with the Examiner's position but only wish to advance the prosecution of the present application.

In the Office Action at pages 9-10, the Examiner has rejected claims 3, 4, 21, 22, and 24 under 35 U.S.C. § 103(a) as allegedly unpatentable over Pruitt, cited *supra*, in view of Wieland *et al.*, cited *supra*, and Rubenstein *et al.*, cited *supra*, in further view of

Vandeyar *et al.* (*Gene* 65:129-133 (1988), IDS document AR10). Applicants respectfully traverse this rejection.

In the interest of expediting the prosecution of the present application, claims 3, 4, 21, 22, and 24 have been cancelled. Therefore, the basis for this rejection is rendered moot. By cancellation of these claims, Applicants do not acquiesce with the Examiner's position but only wish to advance the prosecution of the present application.

In the Office Action at page 10, the Examiner has rejected claim 9 under 35 U.S.C. § 103(a) as allegedly unpatentable over Pruitt, cited *supra*, in view of Wieland *et al.*, cited *supra*, and Rubenstein *et al.*, cited *supra*, in further view of Welcher *et al.* (*Nucl. Acids Res.* 14:10027-10004 (1986), IDS document AS11). Applicants respectfully traverse this rejection.

In the interest of expediting the prosecution of the present application, claim 9 has been cancelled. Therefore the basis for this rejection is rendered moot. By cancellation of this claim, Applicants do not acquiesce with the Examiner's position but only wish to advance the prosecution of the present application.

In the Office Action at page 10, the Examiner has rejected claim 20 under 35 U.S.C. § 103(a) as allegedly unpatentable over Pruitt, cited *supra*, in view of Wieland *et al.*, cited *supra*, and Rubenstein *et al.*, cited *supra*, in further view of Rashtchian *et al.* (*Anal. Biochem.* 206:91-97 (1992), IDS document AR7). Applicants respectfully traverse this rejection.

In the interest of expediting the prosecution of the present application, claim 20 has been cancelled. Therefore the basis for this rejection is rendered moot. By cancellation of this claim, Applicants do not acquiesce with the Examiner's position but only wish to advance the prosecution of the present application.

The Obviousness Double-Patenting Rejection

In the Office Action at pages 11-12, the Examiner has rejected claims 2, 6, 13-19, and 23 under the judicially created doctrine of obviousness-type double patenting over claims 1, 2, 8-13, and 17 of U.S. Patent No. 5,500,356. The Examiner has also rejected claims 1, 2, 6, 7, and 13-17 under the judicially created doctrine of obviousness-type double patenting over claims 1, 2, 20, 23-28, 40 and 41 of U.S. Patent No. 5,759,778. In addition, the Examiner has provisionally rejected claims 2 and 6 under the judicially created doctrine of obviousness-type double patenting over claims 1, 28, and 43 of co-pending Application No. 09/018,989. Applicants respectfully traverse these rejections.

In the interest of expediting the prosecution of the present application, claims 1, 2, 6, 7, and 13-19 have been cancelled. Therefore the basis for this rejection is rendered moot. By cancellation of these claims, Applicants do not acquiesce with the Examiner's position but only wish to advance the prosecution of the present application.

Conclusion

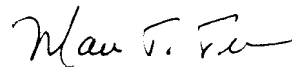
All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will

expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Mau T. Tran
Registration No. P-53,699

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1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600

Version with markings to show changes made

Claims 1-27 have been cancelled.

New claims 28-48 are sought to be entered.

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